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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,479	11/03/2003	Wen-Ching Hou	3624-0135P	3231

2292 7590 01/12/2005

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT PAPER NUMBER

3711

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/698,479

Applicant(s)

HOU ET AL.

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 11-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

This Office action is responsive to communication received 12/17/2004 – election.

Claims 1-16 remain pending.

Claims 3 and 11-16 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 12/17/2004.

Applicant's election with traverse of Species II (Figures 5-7a), claims 1, 2 and 4-10) in the reply filed on 12/17/2004 is acknowledged. The traversal is on the ground(s) that it should not be any undue burden to the Examiner to examine all of the claims. Moreover, applicant alleges that generic claim 1 is in condition for allowance and the election requirement should therefor be withdrawn. This is not found persuasive because this is not a traversal of the issues. The applicant has not pointed out any "error" in the election of species requirement. Here, the diverse species have been correctly set forth. Applicant has not stated why there would not appear to be any undue burden on the part of the Examiner, but has simply stated a conclusion.

The requirement is still deemed proper and is therefore made FINAL.

Following is an action on the MERITS:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Igarashi. As to claim 1, note club head body (10) including a front side with a perimeter and a striking plate (Figure 1). The language "adapted to be mounted to the front side of the golf club head body" is merely functional. Note the hole provided in the perimeter of the head nearest the toe (Figures 1, 3). As to claim 2, the hole is a through-hole. As to claim 4, a light material such as urethane foam fills the hole and the cavity behind the striking face and may be considered to be a reinforcing block and serves to reduce vibration and strengthen the head (col. 5, lines 51-60). As to claim 7, a light material such as urethane foam fills the cavity behind the striking face and may be considered to be a reinforcing layer and serves to further provide structural integrity and vibration absorption. (col. 5, lines 51-60).

Claims 5, 6, 8, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Igarashi in view of Rogers. Igarashi shows every feature claimed with the exception of the specific method of introducing the light material (claims 5 and 8), the specific material make-up of the light material (claims 6 and 9) and the manner of attaching the face to the main body (claim 10). Rogers shows it to be old in the art to

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include a filler material (34) of low-density construction behind the striking face. The filler is introduced into the cavity and allowed to harden. In any event, the claimed heat pressing or injection molding of claim 6 would not appear to limit the structure of the claim, as the final product including the club head and filler shown in Rogers would appear to present the same club head construction. In view of the patent of Rogers and the above reasoning, it would have been obvious to modify the Igarashi device by introducing the filler material, whether foam or epoxy, using any appropriate method, the reason being to take advantage of materials and manufacturing techniques known in the art. With respect to the claimed material, here again, Rogers provides the skilled artisan with the motivation to use an epoxy, i.e., a polymer material, as the filler. Clearly, the skilled artisan would have been able to modify the Igarashi device by selecting a filler material based upon its known characteristics (e.g., the ability to absorb vibration), said selection being recognized in the Patent laws as obvious to one of ordinary skill in the art. See In re Hopkins 145 USPQ 140. Specific to claim 10, Rogers clearly obviates the use of the reinforcing layer completely covering the engaging edge in a joint area between the back of the striking plate and the inner face of the perimeter wall (Figures 3, 4, 5). Note, in Igarashi the face is cast as part of the body, so no real "engaging edge" exists. However, the fact that the claimed invention requires welding, brazing, pressing, screwing or insertion to attach the face would appear to connote limitations associated with the method of assembling the club head. These limitations would not appear to further limit the structure of the final product. Each of Igarashi and Rogers, in their completed state, include a filler material that

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provides a covering or backing of the entire rear of the striking plate, including the perimeter edges at the rear face. Thus, the reinforcing layer (urethane foam of Igarashi or epoxy resin of Rogers) is able to absorb stress during striking of a golf ball.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note the shock absorption material in the perimeter of Biafore. Gallagher shows an opening in the toe perimeter wall. Note filler (12) in Campau.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sebastiano Passaniti
Primary Examiner
Art Unit 3711

S.Passaniti/sp
January 10, 2005